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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/339,325	06/23/1999	YOAV SHOHAM	ARIBP032	2458
21912	7590	10/11/2011		
VAN PELT, YI & JAMES LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO, CA 95014			EXAMINER VAN BRAMER, JOHN W	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 10/11/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary****Application No.**

09/339,325

**Applicant(s)**

SHOHAM ET AL.

**Examiner**

JOHN VAN BRAMER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 July 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 11, 22, 24-29, 32-37 and 40-47 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 11, 22, 24-29, 32-37, and 40-47 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on July 4, 2011, has amended Claims 22, 24, 26, 28, 29, 34, 36, 37, 40, and 42. No claims were cancelled and new claim 47 was added. Thus, the currently pending claims considered below remain Claims 11, 22, 24-29, 32-37, and 40-47.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11, 22, 24-29, 32-37, and 40-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly amended independent claims 22, 28, 36 recite the limitation "wherein at least one user selectable trading primitive pertains to an aspect of an auction that is different from a reserve price and is different from a start time and is different from an end time". The examiner can find no support in the applicant's specification for the claimed negative limitation. As per MPEP 2173.05(i) any claim containing a negative limitation which does not have basis

in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 11, 22, 24-29, 32-37, and 40-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Woolston (U.S. Patent Number: 5,845,265).

Claims 22, 28, and 36: Woolston discloses a system, method of managing the trading of goods auctioned by auction participants, and computer program product for managing the trading of goods auctioned by auction participants comprising:

- a. A market specification console (posting terminal 700) configured to receive from a user:
  1. A specification of a first market phase, wherein the first market phase is defined by one or more user selectable trading primitives that dictate the

- behavior of one or more components in a programmable auction server, and wherein at least one user selectable trading primitives pertains to an aspect of an auction that is different from a reserve price and is different from a start time and is different from an end time. (Col 4, lines 10-37; Col 5, line 48 through Col 6, line 53; Col 10, lines 3-18; and Col 15, line 23 - Col 16, line 58)
- b. A programmable auction server (market maker computer 800), in communication with the market specification console, to programmable auction server configured to : receive, from the market specification console, a market protocol comprising the received market phase specification and manage trading of at least one good auctioned by at least one auction participant in accordance with the protocol. (Col 4, lines 39-58; Col 5, line 48 through Col 6, line 53; and Col 14, lines 51-63).

Claim 11: Woolston discloses the system of Claim 22, wherein the at least one market specification console includes a graphical user interface. (Col 15, line 23 - Col 16, line 58; and Figure 13).

Claims 29, and 37: Woolston discloses the method, and computer program product of Claims 28, and 36 respectively, wherein the specification of the market phase is received via a market specification console that includes a graphical user interface. (Col 15, line 23 - Col 16, line 58; and Figure 13).

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Claims 24, 32, and 40: Woolston discloses the system, method, and computer program product for conducting auctions as in Claims 22, 28, and 36 respectively, wherein the market phase includes an interval in which at least one transaction occurs. (Col 5, line 48 through Col 6, line 53)

Claim 25: Woolston discloses the system of Claim 24, wherein the transaction comprises submitting a bid. (Col 5, line 48 through Col 6, line 53; Col 15, line 23 - Col 16, line 58)

Claim 33, and 41: Woolston discloses the method, and computer program product of Claims 32, and 40 respectively, wherein the transaction is selected from the group including submitting a bid, admitting a bid, withdrawing a bid, and replacing a bid. (Col 5, line 48 through Col 6, line 53; Col 15, line 23 - Col 16, line 58)

Claims 26, 34, and 42: Woolston discloses the system, method, and computer program product of Claims 22, 28, and 36 respectively, where in the market phase is terminated by a condition. (Col 5, line 48 through Col 6, line 53)

Claims 27, 35, and 43: Woolston discloses the system, method, and computer program product of Claims 26, 34, and 42 respectively, wherein the condition is a time period. (Col 5, line 48 through Col 6, line 53)

Claim 44: Woolston discloses the system of 24 wherein the transaction comprises admitting a bid. (Col 5, line 48 through Col 6, line 53; Col 15, line 23 - Col 16, line 58)

Claim 45: Woolston discloses the system of 24 wherein the transaction comprises withdrawing a bid. (Col 5, line 48 through Col 6, line 53; Col 10, lines 33-64; Col 12, lines 11-19; Col 20, line 65 through Col 21, line 6)

Claim 46: Woolston discloses the system of 24 wherein the transaction comprises replacing a bid. (Col 5, line 48 through Col 6, line 53; Col 10, lines 33-64; Col 12, lines 11-19; Col 20, line 65 through Col 21, line 6)

Claim 47: Woolston discloses the system of claim 22 wherein the market phase is a first market phase and wherein the market specification console is further configured to receive a specification of a succeeding phase, wherein the succeeding phase is defined by one or more user selectable trading primitives that dictate the behavior of one or more components in a programmable auction server. (Col 4, lines 10-37; Col 5, line 48 through Col 6, line 53; Col 10, lines 3-18; and Col 15, line 23 - Col 16, line 58)

6. Claims 11, 22, 24-29, 32-37, and 40-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Fisher et al. (U.S. Patent Number: 6,243,691).

Claims 22, 28, and 36: Fisher discloses a system, method of managing the trading of goods auctioned by auction participants, and computer program product for managing the trading of goods auctioned by auction participants comprising:

- a. A market specification console (Col 4, lines 30-43; and Col 5, line 49 through Col 6, line 25) configured to receive from a user:
  1. A specification of a first market phase, wherein the first market phase is defined by one or more user selectable trading primitives that dictate the behavior of one or more components in a programmable auction server and wherein at least one user selectable trading primitive pertains to an aspect of an auction that is different from a reserve price and is different from a start time and different from an end time. (Col 4, lines 30-43; Col 5, line 49 through Col 6, line 25; Col 7, lines 43-52; Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )
- b. A programmable auction server, in communication with the market specification console, to programmable auction server configured to : receive, from the market specification console, a market protocol comprising the received market phase specification and manage trading of at least one good auctioned by at least one auction participant in accordance with the protocol. (Col 7, lines 20-52; Col 8, lines 27-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24).



Claim 11: Fisher discloses the system of Claim 22, wherein the at least one market specification console includes a graphical user interface. (Fig.1 item 300; Col 4, lines 30-43; Col 5, line 49 through Col 6, line 25; Col 7, lines 43-52; Col 8, lines 13-38).

Claims 29, and 37: Fisher discloses the method, and computer program product of Claims 28, and 36 respectively, wherein the specification of the market phase is received via a market specification console that includes a graphical user interface. (Fig.1 item 300; Col 4, lines 30-43; Col 5, line 49 through Col 6, line 25; Col 7, lines 43-52; Col 8, lines 13-38).

Claims 24, 32, and 40: Fisher discloses the system, method, and computer program product for conducting auctions as in Claims 22, 28, and 36 respectively, wherein the market phase includes an interval in which at least one transaction occurs. (Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claim 25: Fisher discloses the system of Claim 24, wherein the transaction comprises submitting a bid. (Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claim 33, and 41: Fisher discloses the method, and computer program product of Claims 32, and 40 respectively, wherein the transaction is selected from the group including submitting a bid, admitting a bid, withdrawing a bid, and replacing a bid. (Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claims 26, 34, and 42: Fisher discloses the system, method, and computer program product of Claims 22, 28, and 36 respectively, where in the market phase is terminated by a condition. (Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claims 27, 35, and 43: Fisher discloses the system, method, and computer program product of Claims 26, 34, and 42 respectively, wherein the condition is a time period. (Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claim 44: Fisher discloses the system of 24 wherein the transaction comprises admitting a bid. (Col 7, lines 20-35; Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claim 45: Fisher discloses the system of 24 wherein the transaction comprises withdrawing a bid. (Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claim 46: Fisher discloses the system of 24 wherein the transaction comprises replacing a bid. (Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

Claim 47: Fisher discloses the system of claim 22 wherein the market phase is a first market phase and wherein the market specification console is further configured to receive a specification of a succeeding phase, wherein the succeeding phase is defined by one or more user selectable trading primitives that dictate the behavior of one or more components in a programmable auction server. (Col 4, lines 30-43; Col 5, line 49 through Col 6, line 25; Col 7, lines 43-52; Col 8, lines 13-38; Col 8, line 56 through Col 9, line 6; Col 11, lines 14-34; Col 12, lines 1-17; Col 12, lines 33-41, and Col 12, line 63 through Col 13, line 24 )

***Response to Arguments***

7. Applicant's arguments filed July 4, 2011 have been fully considered but they are not persuasive. The applicant argues that neither Fisher nor Woolston discloses a specification of a first market phase, wherein the first market phase is defined by one or more user selectable trading primitives that dictate the behavior of one or more components in a programmable auction server and wherein at least one user selectable trading primitive pertains to an aspect of an auction that is different from a reserve price and is different from a start time and is different from an end time. However, the teachings Fisher disclose receiving a bid increment value that is to be displayed on the catalog page in Col 5, line 49 through Col 6. Since a bid increment is a trading primitive that is different from a reserve price and is different from a start time and is different from an end time value, the limitations of the claims as currently written have been met. Fisher additionally discloses that the format of the auction can be chosen in Col 9, lines 31-42, and Col 10, line 10 through Col 11, line 54. An auction format is also a trading primitive that is different from a reserve price and is different from a start time and is different from an end time value. Additionally, Woolston discloses receiving a trading primitive such as a retail price and a wholesale price and executing the disclosed system with such a trading primitive in Col 15, line 23 through Col 16, line 58. Since a wholesale price and retail price is a trading primitive that is different from a reserve price and is different from a start time and is different from an end time value, the limitations of the claims as currently written have been met.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/  
John Van Bramer  
Primary Examiner, Art Unit 3622